

DEC 06 2001



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In re Application of
CHIBA et al.
Application No.: 09/807,322
PCT No.: PCT/EP99/07691
Int. Filing Date: 13 October 1999
Priority Date: 26 October 1998
Attorney Docket No.: MO6319/SBU-1
For: METHOD OF PREPARING RIGID
POLYURETHANE FOAM

DECISION ON
PAPERS UNDER 37 CFR 1.42

This decision is in response to applicants' "Renewed Submission Under 37 CFR 1.42" filed 28 September 2001. In a decision dated 13 September 2001, applicants' petition filed 18 May 2001 was dismissed because the declaration was not acceptable under 37 CFR 1.497(a)(3).

On 28 September 2001, applicants filed the present papers under 37 CFR 1.42.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration submitted on 18 May 2001 was executed by Kazuko Chiba, Kumiko Chiba, and Mamiko Chiba as "heir" to the deceased inventor Takanori Chiba. Yasuo Yoshitoshi, Japanese counsel, avers that, "Kuzuko Chiba Ms. Kumiko Chiba, Ms. Mimiko Chiba are the legal representative and heirs....Takanori Chiba." Therefore, the declaration submitted on 18 May 2001 appears to have been executed by the proper party under 37 CFR 1.42. However, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

As stated in the previous decision, 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental

oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the signing heir. The declaration filed on 18 May 2001 provides this information with respect to the signing legal representative and heirs, but not the inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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